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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/738,598
Filing Date: December 15, 2000
Appellant(s): ALLAM ET AL.

Jon P. Christensen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/06/2006 appealing from the Office action mailed 04/04/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

GROUNDS OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief: The provisional obvious-type double patenting rejection of claim 1-10, 29, 44, 46-51 and 57.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,018,749	Rivette et al.	1-2000
5,806,079	Rivette et al.	9-1998
5241671	Reed et al.	8-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 remain rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. (US006018749A, filed 4/9/1998) hereinafter Rivette-749.

Regarding independent claims 1, 44, 46, and 57, Rivette-749 teaches displaying in a first window a physical page (Fig. 59). The graphical border of the windows surrounding the text is the visual reference, which is disposed on the physical page. The borders of the window are a visual marking, and that marking is disposed on the physical page, e.g. within the page. As is clear from the disclosure as a whole, the image on the right is the physical page representation is the image of the published patent, which is a physical page. Rivette's meaning is confirmed (col. 14, ll. 50-67) by the fact that it is an image of the physical page. As one of ordinary skill in the art would recognize, the image shown on the right is only a portion of the physical page and as

such, the visual reference is disposed on the page. The contents shown within the borders of the window are clearly identified by being with the visual reference.

Rivette-749 teaches extracting all of the information on the physical page (col. 19, line 65 – col. 21, line 11), which would include the portion identified by the visual reference. Rivette-749 teaches presenting the extracted information in a second window and that the information is free-flowing (Fig. 59).

Regarding dependent claim 2, Rivette-749 teaches the physical page is represented in an electronic page view (Fig. 59).

Regarding dependent claim 3, Rivette-749 discloses that the physical page is represented as an icon including a thumbnail of the physical page (Fig. 65).

Regarding dependent claim 4, Rivette-749 discloses the first and second windows are the same window (Fig. 59, Patentworks window).

Regarding dependent claim 6, Rivette-749 discloses the step of extracting information further comprises the step of selecting a markup annotation from the physical page and converting the information contained in the selected markup annotation to information for use in the second window (col. 41, ll. 18-44).

Regarding dependent claim 7, Rivette-749 discloses the step of selecting further comprises the step of enclosing the markup annotation with a box (Fig. 61).

Regarding dependent claim 9, Rivette-749 discloses the second window further comprises a control panel for managing the extracted information (col. 33, ll. 64-67.).

Regarding dependent claim 10, Rivette-749 discloses the extracted information may be viewed simultaneously in a multiple of enhanced interactive windows (col. 37, ll. 39-55).

Regarding dependent claim 11, Rivette-749 discloses the visual reference on the physical page is a box with a colored border (Fig. 59).

Regarding dependent claim 12, Rivette-749 discloses the step of extracting information further comprises the step of extracting information when a computer user clicks in the first window by a selection device including a mouse and the information, which is extracted, is around the point of the mouse click (col. 25, ll. 36-43).

Regarding dependent claim 13, Rivette-749 discloses selecting a bookmark and retrieving information associated with the bookmark (col. 41, ll. 19-45).

Regarding dependent claim 14, Rivette-749 discloses retrieving information associated with a structural element when the user selects the structural element (col. 33, ll. 50-62)

Regarding dependent claim 15, Rivette-749 discloses the information emphasized by a visual reference is termed a markup annotation and each markup annotation is associated with a structural element stored in a database of structural elements (col. 4, ll. 21-37).

Regarding dependent claim 16, Rivette-749 discloses retrieving an associated structural element from a database of structural elements and displaying data from the markup annotations associated with the structural elements in the second window (col. 41, ll. 19-45).

Regarding dependent claim 17, Rivette-749 discloses enlarging and reducing visual elements (col. 36, ll. 17-34).

Regarding dependent claim 18, Rivette-749 discloses that the visual elements include graphic images, clip art, and picture objects (col. 36, ll. 17-34).

Regarding dependent claim 21, Rivette-749 discloses selecting a symbol representing extracted information in the second window, and displaying document elements associated with the symbol in the first window (col. 41, ll. 19-45).

Regarding dependent claim 22, Rivette-749 discloses that the symbol includes icons for figures (col. 36, ll. 41-46).

Regarding dependent claim 23, Rivette-749 discloses that selecting a symbol further comprises the step of enlarging or reducing a zoom view of the extracted information in the first window (col. 36, ll. 17-34).

Regarding dependent claim 24, Rivette-749 discloses that selecting a symbol displays the extracted information in a third window (col. 37, ll. 39-55).

Regarding dependent claim 25, Rivette-749 discloses that selecting a symbol displays text in another enhanced interactive window (col. 37, ll. 39-55).

Regarding dependent claim 26, Rivette-749 inherently discloses executing code as the system of Rivette-749 is software based.

Regarding dependent claim 27, Rivette-749 discloses that document elements include information comprising tables, figures, graphs, charts, illustration graphics, photos, clip art audio and audiovisual elements (Fig. 59).

Regarding dependent claim 28, Rivette-749 discloses that the step of selecting includes clicking on the symbols with a mouse (col. 41, ll. 19-45).

Regarding dependent claims 8 and 30, Rivette-749 discloses the window may be moved anywhere (col. 46, ll. 13-30).

Regarding dependent claim 31, Rivette-749 discloses that all functions maybe accessed without clicking (col. 26, line 36 – col. 27, line 2).

Regarding dependent claim 32, Rivette-749 discloses that the step of displaying extracted information further comprises the step of advancing extracted information in the second window by an action including a keystroke (col. 26, line 36 – col. 27, line 2).

Regarding dependent claim 33, Rivette-749 discloses that the step of advancing extracted information in the second window further comprises the step of advancing the physical page displayed in the first window (col. 17, ll. 17-25).

Regarding dependent claim 34, Rivette-749 discloses that the step of advancing extracted information in the second window further comprises the step of advancing the visual reference to the extracted information in the physical page displayed in the first window (col. 17, ll. 17-25).

Regarding dependent claim 35, Rivette-749 discloses that the extracted information will start at the top of the second window (Fig. 59).

Regarding dependent claim 36, Rivette-749 discloses the step of creating a summary document from user created notes, highlights, and other user inputted information (col. 41, ll. 18-44).

Regarding dependent claim 37, Rivette-749 discloses that the step of presenting extracted information further comprises the step of allowing the user to add to the extracted information in the second window (col. 41, ll. 18-44).

Regarding dependent claim 38, Rivette-749 discloses that the step of presenting extracted information further comprises the step of finding words within the second window (col. 30, ll. 26-49).

Regarding dependent claim 42, Rivette-749 discloses that the electronic information is associated with a particular computer (col. 13, ll. 45-54).

Regarding dependent claims 43 and 55, Rivette-749 discloses that the electronic information may be shared between computer users and between computers (col. 13, ll. 52-66).

Regarding dependent claim 45, Rivette-749 discloses selecting extracted information represented by symbols in the second window, and displaying document elements associated with the symbols in a third window (col. 41, ll. 19-45).

Regarding dependent claim 47, Rivette-749 discloses that the enhanced interactive window comprises at least one window that displays extracted -Information from the physical pages (Fig. 59).

Regarding dependent claim 49, Rivette-749 discloses a database for storing annotations, extracted electronic information, and the relationships in the system (Fig. 3, 60).

Regarding dependent claim 50, Rivette-749 discloses structure tree for storing relationship information associating electronic information with extracted electronic information (col. 52, ll. 56-61).

Regarding dependent claim 51, Rivette-749 discloses a visual reference emphasizing the electronic information is displayed on the physical pages (col. 4, ll. 21-37).

Regarding dependent claim 52, Rivette-749 discloses that the visual reference is a box with a colored border (Fig. 59).

Regarding dependent claim 56, Rivette-749 discloses that the graphic images of physical pages adhere to a page description format (Fig. 59).

Regarding dependent claim 58, Rivette-749 teaches displaying in a first window a physical page (Fig. 59). The graphical border of the windows surrounding the text is the visual reference, which is disposed on the physical page. The borders of the window are a visual marking, and that marking is disposed on the physical page, e.g. within the page. As is clear from the disclosure as a whole, the image on the right is the physical page representation is the image of the published patent, which is a physical page. Rivette's meaning is confirmed (col. 14, ll. 50-67) by the fact that it is an image of the physical page. As one of ordinary skill in the art would recognize, the image shown on the right is only a portion of the physical page and as such, the visual reference is disposed on the page. The contents shown within the borders of the window are clearly identified by being with the visual reference.

Rivette-749 teaches extracting the information on the physical page (col. 19, line 65 – col. 21, line 11). Rivette-749 teaches extracting all of the information on the physical page (col. 19, line 65 – col. 21, line 11), which would include the portion identified by the visual reference. Rivette-749 discloses that the step of advancing extracted information in the second window further comprises the step of advancing the physical page displayed in the first window (col. 17, ll. 17-25).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 5,19,20,29 and 48 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749, and further in view of Rivette et al. (US005806079A, granted 9/8/1998) hereinafter Rivette-079.**

Regarding dependent claim 5, 29, and 48, Rivette-749 discloses the second window is an enhanced interactive window including a thumbnail image of a physical page, a graphic image of a physical page, text, free flowing text, icons, menus, and control elements (Fig. 59). Rivette-749 does not explicitly disclose hyperlinks. Rivette-079 teaches hyperlinks in document browser (col. 1, ll. 55-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to use hyperlinks in order to link related documents (Rivette-079, col. 1, ll. 43-54).

Regarding dependent claim(s) 19, Rivette-749 does not teach hyperlinks. Rivette-079 teaches hyperlinks as described in claim 5 above. Official Notice is taken that it was well known and desired in the art at the time of the invention to displaying hyperlinks as hypertext.

Regarding dependent claim(s) 20, Rivette-749 does not teach hyperlinks. Rivette-079 teaches hyperlinks in document browser (col. 1, ll. 55-60) that link to documents, which are visual elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to use hyperlinks in order to link related documents (Rivette-079, col. 1, ll. 43-54).

5. **Claims 39-41 and 53 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749, and further in view of Reed et al. (US005241671A, granted 8/31/1993).**

Regarding dependent claims 39 and 53, Rivette-749 does not explicitly disclose a dictionary. Reed discloses presenting a dictionary to a user to retrieve definitions (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

Regarding dependent claim 40, Rivette-749 does not explicitly disclose a dictionary. Reed discloses presenting an information database to a user to retrieve definitions for unfamiliar words (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

Regarding dependent claim 41, Rivette-749 does not explicitly disclose a dictionary. Reed discloses examining extracted information for unfamiliar words and displaying definitions for the unfamiliar words (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

6. Claim 54 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749.

Regarding dependent claim 54, Rivette-749 does not explicitly disclose a lock. Official Notice is taken that it was well-known and desirable in the art at the time of the invention to secure any information to one device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the well-known reason in the art of securing data.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-10, 29, 44, 46-51, and 57 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, and 20 of copending Application No. 10/691,927 in view of Rivette-079.

The copending application teaches all elements of the instant claims except free-flowing text. Rivette-079 teaches free-flowing text (Fig. 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize free-flowing so that parts of the document would not be cut off.

This is a provisional obviousness-type double patenting rejection.

(10) Response to Argument

Regarding Appellant's remarks p. 10, para. 1, regarding independent claim(s) 1, :

Appellant alleges the rejection does not contain a visual reference. The rejection states that the graphical border of the windows surrounding the text is the visual reference, which is disposed on the physical page. Appellant alleges that a window that surrounds text by definition is not a "a visual reference disposed on the physical page in the first window." The Office does not understand this allegation, or Appellant's description of the windows as margin. The borders of the window are a visual marking, and that marking is disposed on the physical page, e.g. within the page. As is clear from the disclosure as a whole, the image on the right is the physical page representation is the image of the published patent, which is a physical page. Rivette's meaning is confirmed (col. 14, ll. 50-67) by the fact that it is an image of the physical page. As

one of ordinary skill in the art would recognize, the image shown on the right is only a portion of the physical page and as such, the visual reference is disposed on the page. Appellant does not explain why window is not a visual reference *by definition*, nor does Appellant offer or point to a definition which could contradict the reference.

Regarding Appellant's remarks on p. 10, para. 2, regarding independent claim(s) 1, :

Appellant alleges that even if the window were the visual reference, "the visual reference clearly fails to identify information within a first window, on a physical page, that is to be displayed in a second window." However, this is not a direct quote of the claims, and there are some important differences between such language and the claim itself. Appellant appears to be arguing that the visual reference does not determine the text that is displayed in the second window. However, this is not required by the instant claim language. The claim recites, "a visual reference disposed on the physical page in the first window..." For the sake of this particular argument Appellant has stipulated to that effect. The claim further recites the visual reference "identifies information on a portion of the at last one physical page". The contents shown within the borders of the window are clearly identified by being with the visual reference. The claim then recites "extracting the information identified by the visual reference." As described in the rejection Rivette-749 teaches extracting all of the information on the physical page (col. 19, line 65 – col. 21, line 11), which would include the portion identified by the visual reference. There is no requirement in the claim that only the identified portions be extracted. For this reason, Appellant's argument fails and Rivette-749 does teach the claim as described in the rejection.

Regarding Appellant's remarks on p. 10 para. 3, regarding claim 1:

Appellant alleges that the Rivette-749 patent fails to attach any significance to the text content, as well as text equivalence. However, it is noted that the features upon which Appellant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Nothing in Appellant's argument addresses the specific claim language recited.

Regarding Appellant's remarks on p. 11 para .1:

Similar to the arguments presented and answered above (p. 10, para. 2), Appellant is alleging the Rivette does not *only* extract the identified information. As explained above, the claim does not require this. The fact that Rivette extracts information from the whole patent does not contradict the claim language because the identified information is also extracted.

Regarding Appellant's remarks on p. 11 para. 2 through p. 12:

Appellant alleges the reference is directed to another different invention and solves a different problem. MPEP § 2131.05 recites:

> "Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See also *State Contracting & Eng ' g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (The question of whether a reference is analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.).

In this case, the instant rejection is anticipatory and therefore Appellant's arguments are inapplicable. Additionally, the majority of features Appellant is relying on are not claimed.

Regarding Appellant's remarks on p. 13 Sections B-D:

Appellant relies on arguments answered above.

Regarding Appellant's remarks on p.16, para. 2:

Although Appellant does not mention a specific claim it appears Appellant is referring to the rejection of claims 5, 19, 20, 29 and 48. Appellant does not mention a particular legal rationale in this case of why the obviousness rejection fails, but generally alleges the rejection is improper because Rivette-079 describes the hyperlinks as undesirable. However, Appellant does not specifically point to a location in Rivette which disparages hyperlinks. The section the Office has cited, *specifically* states that it is desirable (Rivette-079, col. 1, ll. 43-54).

Although Appellant does not mention a specific claim it appears Appellant is referring to the rejection of claims 39-41 and 53. Appellant does not mention a particular legal rationale in this case of why the obviousness rejection fails, but generally alleges the rejection is improper, because Rivette does not recognize that dictionary is needed. It is unclear what Appellant is trying to argue. The Office has specifically cited motivation within the prior art, and Appellant has not refuted it.

Regarding Appellant's remarks on p.16, para. 4:

Although Appellant does not mention a specific claim it appears Appellant is referring to the rejection of claim 54. Appellant does not mention a particular legal rationale in this case of why the obviousness rejection fails, but generally alleges the rejection is improper, because Rivette has no need for a lock. It is noted that Appellant is not traversing the Official Notice of the commonness of such a lock, merely its combination with Rivette. Appellant alleges patents do not need restrictions on copying. However, Rivette merely uses patents as an example and contemplates all documents in general (col. 14, ll. 39-42).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Adam Queler

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

November 2, 2006

Conferees:

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